IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	KidVid, Inc.	)	
		)	
Mark:	A LITTLE GENIUS IN THE MAKING	)	
		)	Trademark Law Office 110
Serial No.:	75/710402	)	
		)	Trademark Attorney Rebecca A. Smith
Filed:	June 16, 1999	)	

The Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Brief in Support of Appeal

History

In Law Office Action No. 1, the Office suspended the application of the subject mark . . . A LITTLE GENIUS IN THE MAKING (Serial No. 75/710402) for a "series of audio/video works, namely, prerecorded videotapes, compact discs, and audio cassettes containing classical music, images depicting infants and children in playful activities, and the functionality of various objects, for developing and improving the creative and intellectual faculties and brain development of infants and children" on the ground that there may be a likelihood of confusion between Applicant's mark and the prior pending applications for the marks LITTLE GENIUS (Serial No. 75/566818) for "musical sound recordings and musical video recordings," and for "printed matter in the nature of a series of children's books...," and LITTLE GENIUS (Serial No. 75/566833) for "clothing, namely, dresses, jumpers..." and for "toys, namely, bathtub toys, construction toys... "

In Law Office Action No. 2, the prior pending marks had matured into registrations, and the Office again refused registration of Applicant's mark on the basis that all of the marks share the term "little genius," and thus, "consumers encountering these marks are likely to believe they are a family of marks all incorporating the terms "little genius." In addition, the Office found that the "goods of the parties are highly similar since they are both toys."

In Law Office Action No.3, the Office continued its refusal based on Registration No. 2372130, finding that, because both marks contain the identical terms "little genius," "consumers encountering both marks are likely to believe they are a family of marks containing both these terms."

Finally, under application for reconsideration, the Examiner rejected Applicant's arguments "given the similarities of the goods and the marks."

Likelihood of Confusion

To support its contention that the marks will cause a likelihood of confusion, the Office maintains that the terms A and IN THE MAKING are mere additions to the term LITTLE GENIUS which create little difference between the two marks. To support its position, the Office relies on the court's holding in Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc., 526 F.2d 556, 188 USPQ 105 (CCPA 1975).

Applicant submits that the court's holding is inapplicable to the present case where the mark LITTLE GENIUS, as used in connection with educational materials for children, is not an arbitrary mark but a suggestive one. Because the mark is suggestive, therefore, consumers are less likely to associate the registrant of LITTLE GENIUS with all products that have an educational purpose. Likewise, in Lilly Pulitzer, Inc. v. Lilli Ann Corp., 376 F.2d 324, 153 USPQ 406 (CCPA 1967), the marks THE LILLY and LILLI ANN are arbitrary because they do not suggest anything to the consumer about the type of product or service they designate. Furthermore, in In re El Torito Restaurants Inc., 9 USPQ2d 2002 (TTAB1988), also cited in the Office Action, the Trademark Trial and Appeal Board held that there was a likelihood of confusion between the marks MACHO and MACHO COMBOS for food. The Board noted, however, that the applicant failed to make a showing that the word MACHO "has any descriptive significance or is weak as a trademark in the field of foods or food services." Id. at 2004.

Additionally, In re Riddle, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE") and In re Cosvetic Laboratories, Inc., 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"), also cited in the Office Action, are factually distinguishable from the present case because both of those cases dealt specifically with the addition of a trade name or house mark to an otherwise confusingly similar mark. In In re

Cosvetic Laboratories, Inc., however, the Board noted that "addition of house mark or trade name and/or other material is sufficient to render marks as a whole registrably distinguishable in cases where . . . product marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms."

The Board has held that third party registrations can be used to show that a particular term has been adopted in a certain field, and to show that term has less than arbitrary significance with respect to certain goods or services. See In re Dayco Products-Eaglemotive Inc., 9 USPQ2d 1910 (TTAB 1988) (stating that submission of third party registrations is probative to demonstrate that "Imperial" has been adopted by those in vehicular field to refer to term's ordinary significance as laudatory designation, warranting finding that mark "Imperial" for automotive products, is a relatively weak mark afforded narrower scope of protection). The Applicant's response of December 4, 2001, attached numerous prior registrations of marks which use the word "genius" and/or "little genius" in connection with educational products and services. These registrations support Applicant's position that its addition of the words "in the making" to the LITTLE GENIUS mark renders its mark distinguishable from registrant's mark because the LITTLE GENIUS mark is highly suggestive of educational products for children, and therefore should only be afforded a narrow scope of protection.

Evidence of these third party registrations also shows that others in the field of educational products and services have adopted and registered marks incorporating the word "genius" and the phrase "little genius" and suggests that consumers are not confused as a result of this common term. American Hospital Supply Corporation v. Air Products and Chemicals, Inc., 194 USPQ 340 (TTAB 1977). Moreover, these registrations demonstrate that the remaining portions of the respective marks are sufficient to distinguish the marks as a whole from one another. Id.

The purchasing public is unlikely to believe that Applicant's and registrant's respective marks belong to the same family.

The third Office Action based its finding of likelihood of confusion in part on the proposition that consumers encountering the marks . . . A LITTLE GENIUS IN THE MAKING and LITTLE GENIUS are likely to believe they are a family of marks containing both these terms. Applicant respectfully disagrees. A "family of marks" is a group of marks having recognizable common characteristics, wherein marks are composed and used in such a way that

the public associates not only individual marks, but common characteristics of family, with the trademark owner. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1462 (C.A. Fed. 1991). Thus, simply using a series of marks does not of itself establish the existence of a family, but rather, there must be recognition among the purchasing public that the common characteristic is indicative of a common origin of goods. Id. The Office Action offers no evidence to support its family of marks argument.

Recognition of the family is achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family. Id. at 1463. It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin. Applicant submits that even if the concurrent use of its mark with registrant's mark were sufficient to establish such a "pattern of usage," there is no evidence of recognition by the purchasing public that such usage is indicative of the origin of a family. In fact, Applicant conducted an extensive search of the major wholesale, retail and online sources for purchasing educational games, music and toys, and was unable to find registrant's "little genius" products advertised or sold anywhere. Thus, because there is no evidence that registrant has advertised or sold its products in a public, commercial environment, there is no likelihood that the purchasing public will believe that Applicant's and registrant's marks belong to a common family, or for that matter, that the parties' respective goods are likely to pass through the same channels of trade.

Similarity of Goods and Services

There is no per se rule that if certain goods or services are so related that there must be a likelihood of confusion from the use of similar or identical marks thereon. See e.g., In re British Bulldog, Ltd., 224 U.S.P.Q. 854, 856 (T.T.A.B. 1984) (use of identical mark PLAYERS on shoes and underwear held not to be confusingly similar due to the nature of the goods). See also In re August Storck KG, 218 U.S.P.Q. 823, 825 (T.T.A.B. 1983) (holding that confusion was not likely between JUICY 2 for candy and JUICY BLEND II for ground beef and vegetable protein mix, even though the respective goods were both food products, because the goods were "quite different"); In re Sydel Lingerie Co., Inc., 197 U.S.P.Q. 629 (T.T.A.B. 1977) (BOTTOMS UP for ladies' and children's underwear held not likely to be confused with BOTTOMS UP for men's clothing). Even marks which are identical in sound and/or appearance may create sufficiently

different commercial impressions when applied to the respective parties' goods or services so that there is no likelihood of confusion. T.M.E.P. § 1207.01(b)(i) (citing In re Sears, Roebuck and Co., 2 U.S.P.Q.2d 1312 (T.T.A.B. 1987) (holding CROSS-OVER for bras not likely to be confused with CROSSOVER for ladies sportswear)). Here, the goods and services are not confusingly similar because Registrant's goods are paint supplies whereas Applicant's goods are audio and video recordings designed to familiarize infants and children with various tools used for drawing and painting.

To support its position that "the Applicant's goods and the Registrant's goods emanate from the same sources," the Office Action included examples of registrations covering both prerecorded entertainment and educational materials for children, and paint and crayon sets. Applicant respectfully submits, however, that the mere fact that some registrations cover multiple classes of goods and services does not make it true that all of the classes of goods and services covered in a particular application are similar. For example, the Office Action refers to the mark MIGHTY MORPHIN POWER RANGERS (Registration No. 2114987) as evidence that prerecorded video cassettes, audio cassettes and CD-ROM's in International Class 009 are likely to emanate from the same source as coloring books, crayons and paint sets in International Class 016. The MIGHTY MORPHIN POWER RANGERS registration, however, covers a seemingly endless list of goods and services in International Classes 003, 009, 011, 012, 014, 016, 018, 020, 021, 024, 025, 028 and 041. It cannot reasonably be the Office's position therefore, that all classes of goods and services listed on any given registration are automatically similar. If that were the case, the Office's classification system would be rendered meaningless, and no two Registrants could ever own the same mark regardless of the nature of their respective goods and services.

Moreover, a search of the Office's trademark database reveals that the Office has often approved identical or nearly identical marks for registration, even where the categories of goods and services are arguably related. Some of these marks include LITTLE PRINCESS (Registration No. 0729168) for "costume jewelry for children," and LITTLE PRINCESS (Registration No. 1760711) for "children's slippers, sandals, sneakers, shoes, boots, booties, slipper socks, hiking shoes, crib shoes, and soft and hard sole prewalking shoes;" LITTLE BLESSINGS (Registration No. 2137537) for "printed publications, namely, illustrations for children's books," and LITTLE BLESSINGS (Registration No. 2013710) for "clay figurines;" LITTLE DIPPERS (Registration No. 1192575) for "breaded, cooked, frozen poultry on a stick," LIL' DIPPER (Registration No. 2282039) for "electric slow cookers and electric casseroles," and LITTLE DIPPER (Registration

No. 2046227) for "biscuits, cookies, cakes, pastries and bakery goods;" LITTLE WONDERS (Registration No. 1283391) for "plastic household storage containers for food and covers thereof," LITTLE WONDERS (Registration No. 2439772) for "bed blankets, towels and washcloths," and LITTLE WONDER (Registration No. 1027758) for "lawn and garden equipment-namely, leaf blowers and vacuums, hedge and shrub trimmers, edgers, [lawn mowers,] powerheads for snowblowers and cultivators, [power generators] and parts for the foregoing;" and finally LITTLE LADY (Registration No. 2236211) for "children's playthings, namely, a doll packaged together with a hand tool for threading beads and other hair ornaments onto the doll's hair," and LITTLE LADY BY FOREVER YOURS (Registration No. 2111526) for "flower girl dresses sold exclusively in bridal specialty shops."

Consideration of Other Factors in Determining Likelihood of Confusion

The leading case of Dupont Co. v. General Mills, Inc., 134 F.2d 429, 56 U.S.P.Q. 400 (7th Cir. 1943) lays out the guideposts for the determination of a likelihood of confusion. Among the criteria established by that case are the comparison of sound, sight and meaning or commercial impression. The cases also make it clear that the marks must be considered in the way they are used and perceived In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Further, Dupont calls for a comparison the nature of the goods, the trade channels, and the degree of fame of the marks. All these criteria are deemed relevant to a determination of likelihood of confusion.

In comparing the marks themselves, it is obvious that A LITTLE GENIUS IN THE MAKING as a slogan to further identify the product of applicant, already registered as BRAINY BABY Reg. No. 2,315,020, registered February 1, 2000 is different and distinguishable from the mark LITTLE GENIUS. The mark LITTLE GENIUS like that of Applicant's BRAINY BABY guides one to identify the source or origin of the goods and the contents thereof. However, Applicant's packaging (See Exhibit "A") then adds the mark in issue to further designate and distinguish the product. The meaning and commercial impression criteria of the Dupont case cannot be construed to be the same. Nor can sight and sound be construed as being the same. The two marks are used in a different manner and to gain different benefits from their use.

A copy of the latest packaging of Appellant (See Exhibit "A") reflects the use of the mark for the video of Applicant almost as a seal to reflect the quality o0f the product and that it will enhance and benefit the experience of the infant or child viewing the programming. Therefore,

the meaning and commercial impression should be much different to the average consumer than seeing the title LITTLE GENIUS to identify the particular video by title. The use and perception of a consumer that responds to a video entitled LITTLE GENIUS must obviously be different then from a consumer who reads the mark "BRAINY BABY" followed by the mark reflected in the manner on the enclosed packaging or used as a slogan beneath "BRAINY BABY" as it is on the back of the packaging. It is suggestive of the benefits to be derived as opposed to a title.

Secondly, the comparison of the nature of goods must lead to a question of the specificity of the descriptions of such goods of each mark. In so comparing, LITTLE GENIUS only states that it is "Musical sound recordings and musical video recordings." This is highly different than the description of Applicant's goods described in the introduction as video tapes designed to enhance the intellectual and creative capacities of the infants that view the videos. LITTLE GENIUS does not pinpoint any of these functions suggesting that it is a general video and that they do not appeal to a market for intellectual and creative stiimulus. Applicant's product is sold in stores such as "Learningsmith", "Store of Knowledge" and similar retailers that sell products intended to enhance the learning capacity of infants and youngsters. A careful search of retailers and catalogs by Applicant has not yielded evidence of the product for sale in any of the same locations as that of Applicant.

As to the concern that mark LITTLE GENIUS has achieved any degree of fame which would strengthen their mark, the fact that it cannot be found in stores refutes this argument and, in fact, Applicant's marks are very well-known in the field, both with parents and educators and his company has been the source of many articles and reports.

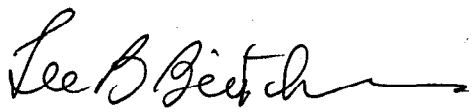
Finally, Applicant's mark is being used only as advertising and will never be competing for name recognition with LITTLE GENIUS which is used to identify the title to the product.

Conclusion

The Applicant has reiterated and expanded its arguments with regard to all issues raised throughout the application process as the basis for the Trademark Office to grant its application for A LITTLE GENIUS IN THE MAKING. It is Applicant's opinion that the Office Action fails to offer any compelling arguments as to why this mark should not be granted. Therefore, for the reasons stated above, the Applicant submits that the refusal by the Trademark Office Examining Attorney

should be reversed and the application approved for registration.

Respectfully Submitted



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